

REMARKS

Claim Status

Claims 1-19 are pending in the Application. The Examiner has allowed claims 14-19, rejected claims 1, 4-8, and 10-13, and objected to claims 2, 3, and 9. Claims 8-13 have been canceled by Applicant.

Claim Rejections – 35 U.S.C. §112 (First Paragraph)

The Examiner rejected Applicant's claims 5 and 11 as failing to comply with the written description requirement under 35 U.S.C. §112 (First Paragraph). Applicant has amended the Description of the Preferred Embodiment to include the fact that the preferred method of making the carabiner is with aluminum. No new matter was added. Therefore, Applicant respectfully requests reconsideration of claim 5 under 35 U.S.C. §112 (First Paragraph).

Claim Rejections – 35 U.S.C. §112 (Second Paragraph)

The Examiner rejected Applicant's claims 8-13 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention under 35 U.S.C. §112 (Second Paragraph). Applicant has canceled claims 8-13 because they have the same subject matter as recited in claims 1, 2, 4, 5, 6, and 7 and are doubly included. Therefore, Applicant respectfully requests reconsideration of the application.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected Applicant's claims under 35 U.S.C. §103(a).

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall

not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

The Examiner rejected claims 1, 4, 5, 7, 8, 10, 11, and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,817,551 issued to Matson ("Matson '551"), in view of U.S. Pat. No. 6,510,599 issued to AmRhein ("AmRhein '599"). The Examiner claimed that the teachings of Matson '551 and AmRhein '599 would have motivated one skilled in the art to combine the two prior art devices to create Applicant's rock-climbing machinery. The Examiner also rejected claims 6 and 12 under 35 U.S.C. §103(a) as obvious over Matson '551 in view of AmRhein '599 and further in view of U.S. Pat. No. 6,776,317 ("Parker '317"). The Applicant respectfully disagrees with Examiner's position.

I. THE EXAMINER FAILED TO MAKE OUT A PRIMA FACIE CASE OF OBVIOUSNESS TO SUPPORT A REJECTION UNDER 35 U.S.C. §103 OF ANY OF APPLICANT'S CLAIMS

The Examiner has failed to establish a prima facie case of obviousness. When examining a patent application, the Examiner has the initial burden of factually supporting a prima facie conclusion of obviousness. *Legal Concepts of Prima Facie Obviousness* MPEP 2142. If the Examiner fails to put forth a prima facie case of obviousness, Applicant has no obligation to come forward with evidence of non-obviousness. *Id* For the Examiner to establish a prima facie case of obviousness, three criteria must be met. *Establishing a Prima Facie Case of Obviousness*, MPEP 2142. First, there must be a suggestion or motivation to modify or combine the prior art references. *Id* Second, there must be a reasonable expectation of success. *Id* Third, the prior art reference must teach or suggest all the claim limitations. *Id* The Applicant respectfully asserts that the Examiner has failed to meet its evidentiary burden.

1. *The Examiner did not cite any suggestion, teaching, or motivation to select and combine Matson '551, AmRhein '599, and Parker '317 to yield the Applicant's claimed invention.*

Case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a

showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). *See also*, *C.R. Bard, Inc. v M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (stating “the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *See, Interconnect Planning Corp. v Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”). The evidence of a suggestion, teaching, or motivation to combine the references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved, yet, the range of sources does not diminish the requirement for actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Claims 1, 4, 5, 7, 8, 10, 11, and 13

The Examiner did not satisfy the evidentiary requirements to prove that either the Matson ‘551 or AmRhein ‘599 references suggest a *motivation to combine their teachings* to disclose or suggest Applicant’s claims 1, 4, 5, 7, 8, 10, 11, and 13. Rather, the Examiner stated that Matson ‘551 disclosed every element of Applicant’s invention except for the hooking devices of Matson ‘551 being carabiners which was disclosed by AmRhein ‘599.

Additionally, the Examiner indicated that Matson '551 in view of AmRhein '599 does not specifically teach that the first and second ends of the band emerge from the top and bottom of the tube, but that Matson '551 does teach that the preload on the band is "not so great as to make it difficult to withdraw the hook" from the tube. The Examiner's conclusion necessarily relied not on an individual with ordinary skill in the art, but on an individual with 20/20 hindsight, and Applicant's disclosure as a blueprint for a solution.

The problem faced by the inventor was how to create a device that would allow a rock climber to reach an out-of-reach fixed anchor in a rock from a lower position while protecting the climber from falling. Associated with this problem are additional issues related to why the current or prior art is deficient to solve the problem. One example of an associated problem was how to create a lightweight climbing tool where the carabiners are rigidly locked into place on the climbing device and can be carried as part of climbing equipment, while at the same time making it strong enough to safely move the climber up the rock. The Examiner never considered this problem, particularly because the Examiner had the benefit of the Applicant's disclosure, which enabled him to see past this additional problem and focus on the solution. In other words, the Examiner solved the problem of "how to create a *device comprising a tube with two carabiners connected with an elastic strap*" not, "how to create a climbing tool that is lightweight and rigidly supports a carabiner, yet is strong enough to safely move a climber up a rock."

Matson '551 may suggest a tube with hooks on each end, but not a lightweight rock-climbing device comprised of a tube with notches, a pair of carabiners, and an elastic band. The notches are a necessary and important element of Applicant's invention that allow the carabiners to lock into place on the tube when a climber is using the device to reach above his or her head to an out-of-reach fixed anchor on the rock. When the band is pulled taut, the carabiners rest in the notches and cannot move around the diameter of the tube. Without the notches, the carabiners would not be rigid and in position to open and fasten on the fixed anchor on the rock. Moreover, the band in Applicant's invention is preferably a length that is slightly longer than the tube so that the band is taut when the first end and the second end of the band are stretched and the first carabiner is placed in the first pair of notches. (Applicant's Disclosure, p. 9, lines 17-20). The tautness of the band allows the first

carabiner to be in a static, rigid position making it easy to attach to an out-of-reach fixed anchor. (Applicant's Disclosure, p. 9, lines 20-21).

The Examiner indicated that Matson '551 discloses "notches" (Examiner's Office Action p. 4, Fig. 1). However, the "notches" described in Matson '551 are flared ends of the tube (Matson '551, Fig. 1, elements 16 and 17) that work with the hooks to form grips around boat mooring attachments (Matson '551, Column 3, lines 12-18). The flared ends in Matson '551 do not prevent the hooks at the ends of the mooring device from moving around the diameter of the tube. In fact, the Examiner never indicated that Matson '551 suggested hooks that will not move around the diameter of the tube. Instead, the Examiner relied on the Applicant's disclosure for the solution to the problem. Given the solution proposed by the Applicant's disclosure, AmRhein '599 was an easy selection for combination with Matson '551. The Examiner's analysis improperly relied on Applicant's disclosure as a blueprint for solving the problem. Therefore, the prior art does not render Applicant's invention obvious.

The Examiner also indicated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stretched the band of Matson '551 such that the first and second ends respectively emerge from the top and bottom of the tube. However, Matson '551 specifically discloses that the band has a preload tension even in the normal position so that when the hooks are in the home position (i.e. not attached to the boat or the dock), they are *received in the flared end sections of the sleeve and the U-shaped attaching section of the hook abuts its associated peripheral flange in the limit position.* (Matson '551, Column 3, lines 20-25) emphasis added. This configuration clearly requires the ends of the band to be fully enclosed in the sleeve so that the U-shaped hooks are resting against the abutment flanges. As described above, the Applicant's invention requires that the band be longer than the tube so that the ends of the band come out the top and bottom of the tube. Therefore, the prior art does not render Applicant's invention obvious.

Claims 6 and 12

The Examiner did not satisfy the evidentiary requirements to prove that Matson '551 in view of AmRhein '599 and further in view of Parker '317 suggests a *motivation to combine*

their teachings to disclose or suggest Applicant's claims 6 and 12. Rather, the Examiner merely stated that Matson '551/AmRhein '599 disclosed every element of Applicant's invention except for explicitly stating that the band is made of nylon. The Examiner's conclusion necessarily relied not on an individual with ordinary skill in the art, but on an individual with 20/20 hindsight, and Applicant's disclosure as a blueprint for a solution.

The problem faced by the inventor was how to create a device that would allow a rock climber to reach an out-of-reach fixed anchor from a lower position. Associated with this problem are additional issues related to why the current or prior art is deficient to solve the problem. One example of an associated problem was how to create a lightweight climbing tool that can be carried as part of climbing equipment, while at the same time making it strong enough to safely move the climber up the rock. The Examiner never considered this problem, particularly because the Examiner had the benefit of the Applicant's disclosure, which enabled him to see past this additional problem and focus on the solution. In other words, the Examiner solved the problem of "how to create a *climbing tool with two carabiners connected with an elastic strap*" not, "how to create a climbing tool that is lightweight yet strong enough to safely move a climber up a rock."

The Examiner did not indicate a suggestion or motivation to combine Matson '551, AmRhein '599, and Parker '317 to create a rock-climbing device that allows the climber to reach a fixed anchor above his or her head. The Examiner merely indicated that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the band of nylon since it is well known in the art as is taught by Parker '317..." (Examiner's Office Action p. 5). This statement does not provide a suggestion or motivation to combine Matson '551, AmRhein '599, and Parker '317. Thus, the Examiner improperly relied on Applicant's disclosure as a blueprint for solving the problem.

Because the Examiner failed to explain why an ordinarily skilled person when faced with the problem solved by Applicant's invention, would 1) reason that the prior art was somehow deficient to solve that problem; and 2) be motivated to select the cited references and combine them, it follows that the Examiner's rejection fails to meet prima facie requirements for an obvious rejection under 35 U.S.C. §103. *See also, In re Rouffet*, 149 F.3d

1350, 1359, 147 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (holding that an examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with *no knowledge of the claimed invention*, would have been motivated to select the references, and select the relevant elements from the references for combination in the manner claimed) (emphasis added).

2. *There is no reasonable expectation of success that the Matson '551, AmRhein '599, and Parker '317 references can be combined to yield the Applicant's invention without destroying the principle of operation of the Matson '551 device.*

A conclusion of obviousness can be maintained by showing a reasonable expectation of success. *In re Rinehart*, 531 F.2d 1048, 1054 (CCPA 1976). However, "[i]f a proposed modification or combination of the prior art would change the operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious." See, *The Proposed Modification Cannot Change the principle of Operation of a Reference*, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). In the present case, there is no reasonable expectation of success when combining Matson '551, AmRhein '599, and Parker '317 that does not also destroy the principle of operation of the Matson '551 device.

If Matson '551 were combined with the teachings of AmRhein '599 and Parker '317, the boat mooring device would not effectively attach a boat to a dock. If Matson '551 were combined with AmRhein '599, the boat mooring device would not have hooks that could be turned 90° relative to the other. (AmRhein '599, Column 4, lines 63-67, Column 5, lines 1-4). Instead, the hooks would be in a rigid position, and the connectors on the boat and the dock would have to have their axes parallel. The modified placement of the hooks would destroy one of the objects of the Matson '551 patent (i.e. the easy mooring of a boat to a variety of boat dock configurations).

Combining Matson '551 with Parker '317 would create a boat mooring device that would not have a rigid tubular sleeve surrounding the stretch cord. Instead, a flexible sheath formed of fabric webbing material would cover the stretch cord (Parker '317, Column 3, lines 41-54). If a flexible sheath covered the stretch cord, one of the objects of Matson '551

would be destroyed (i.e. the covering of the band resisting any compression under the normal forces encountered in use). Thus, there is no reasonable expectation of success to support a conclusion of obviousness.

3. The Matson '551, AmRhein '599, and Parker '317 references are non-analogous prior art to Applicant's present invention.

When analyzing the obviousness of the subject matter at issue, the prior art references must be analogous. See, MPEP 2141.01(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Moreover, the similarities and differences in the structure and function of the inventions are important in determining the non-analogy or analogy of the references. See, *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). In the present case, Matson '551, AmRhein '599, nor Parker '317 are in the field of Applicant's endeavor, nor are the structures and functions of Matson '551, AmRhein '599, and Parker '317 similar to the present invention.

The prior art references and claimed invention are involved in different fields of endeavor. Applicant's invention discloses a rock-climbing device that serves to arrest, or stop the climber from falling should he or she fall or "come off" the rock, while also allowing the rock climber to reach an out-of-reach fixed anchor from a lower position. (Applicant's Background of the Invention p. 2, lines 13-22). Rock climbing is a dangerous and challenging sport. Individuals involved in the sport are continuously searching for ways to make the sport easier and safer. (Applicant's Background of the Invention p. 2, lines 6-7). It is important to keep rock climbers safe on climbs by ensuring that they do not fall. (Applicant's Background of the Invention p. 2, lines 9-12). Applicant's invention provides a rock-climbing device that aids climbers in grasping out-of-reach fixed anchors and also protects climbers from falls and is easy to carry.

In contrast, the boat mooring device disclosed in Matson '551 is used as part of a different structure for a different purpose under different conditions from the rock-climbing

device disclosed by Applicant. The boat mooring device in Matson '551 is "an economical, easy-to-use device which is adapted *to moor a small boat* at a fixed spacing from a dock so that the boat does not get scratched or otherwise damaged while it is moored" (Matson '551, Column 1, lines 5-10) (emphasis added). Moreover, the Matson '551 mooring device is not structurally similar to the Applicant's rock-climbing device. Matson '551 does not disclose a device that can be used to reach over one's head and attach a carabiner to a fixed anchor in a rock. The most significant structural difference between Matson '551 and Applicant's invention are the notches. Matson '551 does not teach notches that will rigidly hold a carabiner in place to attach to a fixed anchor. These differences render Matson '551 a non-analogous prior art reference.

Similarly, AmRhein '599 is also a non-analogous prior art reference. AmRhein '599 consists of a device that will "aid in the installation and removal of carabiners from hard to reach places while climbing and which will further aid in the installation of rope within the installed carabiner." (AmRhein '599, Column 1, lines 9-13). The intended purpose of AmRhein '599 is to install ropes and carabiners to anchors along a rock wall. However, the device described in AmRhein '599 is not capable of attaching to a climber's safety harness to arrest or stop the climber from falling. The device in AmRhein '599 merely allows a climber to place a carabiner in a fixed anchor. Thus, the differences in structure, purpose, and conditions make AmRhein '599 a non-analogous prior art reference.

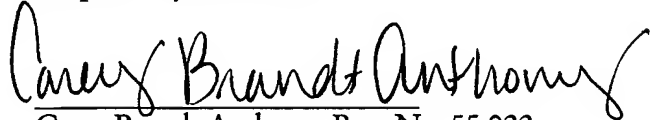
Additionally, Parker '317 is a non-analogous prior art reference. Parker '317 discloses a device that is a "tool lanyard for holding tools. . . ." (Parker '317, Column 1, line 9). Its intended purpose is to secure and arrest the inadvertent dropping of *tools*, and to make safer construction work areas. (Parker '317, Column 1, lines 32-34). In no way does the device disclosed in Parker '317 protect a person from falling. Therefore, the differences in structure, purpose, and conditions make Parker '317 a non-analogous prior art reference.

Conclusion

Applicant believes she has addressed and responded to every point raised in the Examiner's present action. For the reasons stated above, Applicant respectfully requests reconsideration of her application.

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Respectfully submitted,



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